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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 12  
ejs

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Kenneth M. Stirbl

Serial No. 75/489,564

Michael R. Diliberto of Kleinberg & Lerner, L.L.P for  
Kenneth M. Stirbl

William P. Jacobi, Trademark Examining Attorney, Law Office  
110 (Chris A.F. Pedersen, Managing Attorney)<sup>1</sup>

Before Seeherman, Hanak and Quinn, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Kenneth M. Stirbl has appealed from the final refusal  
of the Trademark Examining Attorney to register UIS in  
stylized form, as shown below, for the following services:<sup>2</sup>

installation, repair, and maintenance  
of computers, computer systems,  
computer networks, and  
telecommunications equipment, and

<sup>1</sup> Mr. Jacobi handled the appeal. Rebecca A. Smith was the  
Examining Attorney during the examination of the application.

<sup>2</sup> Application Serial No. 75/489,564, filed May 22, 1998, and  
asserting first use and first use in commerce as of December 6,  
1996. The lining in the drawing is a feature of the mark and is  
not intended to indicate color.

business and office machinery and equipment; (Class 37)

integration of computer systems and networks; consultation services in the fields of computers, computer networks, computer software and hardware, computer software and design and installation, computer network and site design, installation and integration. (Class 42).



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the stylized mark shown below, UIS UNIVERSAL INFORMATION SYSTEMS, INC. (with the words INFORMATION SYSTEMS, INC. disclaimed), previously registered for "providing personnel on a shortterm basis to businesses to perform data processing; microfilm services," (Class 35) and "computer programming services" (Class 42)<sup>3</sup> as to be likely to cause confusion or mistake or to deceive.

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<sup>3</sup> Registration No. 1,087,818, issued March 21, 1978; Section 8 and 15 affidavits received; renewed.



**UNIVERSAL INFORMATION SYSTEMS, INC.**

The appeal has been fully briefed. Applicant withdrew his request for an oral hearing.

Before discussing the substantive issue on appeal, we must address a procedural point. With his reply brief applicant has submitted exhibits relating to the registrant's business and a declaration by his attorney. These materials are manifestly untimely and will not be considered. Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal, and the Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed by the applicant or the Examining Attorney after the appeal is filed. Similarly, we have not considered applicant's comments in his reply brief which were made on the basis of these untimely submissions.

Turning then to the issue of likelihood of confusion, our determination is based on an analysis of all of the probative facts in evidence that are relevant to the

factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

During the examination of the application the Examining Attorney focused on the issue of likelihood of confusion with respect to the programming services in the cited registration, and did not even discuss the registrant's personnel services. A different Examining Attorney prepared the appeal brief, and has argued that "in the context of the registrant's entire recitation of services, the Class 35 services could be interpreted as providing on-site assistance/consultation in performing computer programming services." Brief, p. 7. We disagree. The question of likelihood of confusion must be determined based on the goods and/or services as they are identified in the application and the cited registration. See **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). The Class 35 services as they are identified in the cited registration--providing personnel on a shortterm basis to

businesses to perform data processing; microfilm services-- cannot be considered, as the Examining Attorney suggests, to be on-site assistance/consultation in performing computer programming services. Further, there is no evidence of any relatedness between providing temporary personnel to perform data processing; microfilm services, and the services identified in applicant's application.

Similarly, the Examining Attorney has not discussed in what manner applicant's Class 35 services--installation, maintenance and repair of computers, etc.--are related to the registrant's computer programming services, nor has the Examining Attorney provided evidence as to the relatedness of these services.

With respect to the Class 42 services, applicant argues confusion is not likely because he does not provide computer programming services. However, the Examining Attorney has made of record a number of third-party registrations that show entities have registered a single mark for both computer consultation services (applicant's identification includes such services) and computer programming services. Applicant contends that these registrations are irrelevant because the marks are not "even remotely confusingly similar to either the registrant's mark or the appellant's mark." Reply brief,

pp. 7-8. The purpose of the submission, however, is not to show that there are third-party marks which are similar to applicant's or the registrant's. Rather, third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

This brings us to a consideration of the marks of applicant and the registrant. The Examining Attorney has accurately cited a number of principles of trademark law: although marks must be compared in their entireties, more weight may be given to dominant elements; disclaimed matter is generally less significant; highly suggestive matter generally is entitled to less weight; and a strong mark is entitled to a broader scope of protection.

The difficulty with the Examining Attorney's position is that the determination of the similarity of marks cannot be made simply on the basis of a mechanical application of principles of law. In our view, despite the fact that both marks contain or consist of the letters UIS in stylized forms, applicant's mark and the cited mark convey different commercial impressions. The letter designs themselves are different in appearance. Moreover, the trade name which

appears in the cited mark, although it is in smaller size than the letters UIS, and although the words UNIVERSAL INFORMATION SYSTEMS, INC. are either suggestive or disclaimed, results in further differences between the marks in appearance, as well as in pronunciation and meaning.

It must also be remembered that the services at issue herein, both the registrant's identified computer programming services and applicant's computer consultation services, etc., are rather specialized services which likely will be purchased by knowledgeable individuals exercising a degree of care. When we consider this factor, along with the differences in the marks and the fact that the services are not identical, we find that the Office has not met its burden of proving that confusion is likely.

Decision: The refusal of registration is reversed.